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In re Application of LOPEZ-RODRIGUEZ et al. :  
Application No.: 10/587,792 :  
PCT No.: PCT/EP05/00840 :  
Int. Filing Date: 28 January 2005 :  
Priority Date: 30 January 2004 :  
Attorney Docket No.: 6102-000031/NP :  
For: DIAZA- OR THIAZADIONE :  
DERIVATIVES WITH :  
NEUROPROTECTIVE ACTIVITY :

DECISION ON REQUEST

This decision is issued in response to applicant's "Response to Notification to File Missing Requirements under 35 U.S.C. 371 and Declaration under 35 U.S.C. 371(c)(4) and Inventor Statements under 37 CFR 1.497(d)(1)" filed 16 August 2007 which is being treated as a Petition to Correct Inventorship under 37 CFR 1.497(d). The \$130 petition fee will be charged to Deposit Account no. 08-0750.

**BACKGROUND**

On 28 January 2005, applicant filed international application PCT/EP05/00840 which claimed a priority date of 30 January 2004. The published international application identified five applicant/inventors for the United States: Maria Luz LOPEZ RODRIGUEZ; Bellinda BENHAMU SALAMA; Joaquin DEL RIO ZAMBRANA; Diana FRECHILLA MANSO; and Isabel MARCO MARTINEZ. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 30 July 2006.

On 31 July 2006, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee; a copy of the international application; and a preliminary amendment.

On 27 February 2007, the United States Designated/Elected Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 16 August 2007, applicant filed the present request under 37 CFR 1.497(d).

### DISCUSSION

The present submission seeks to correct the inventorship so as to remove inventor Isabel MARCO MARTINEZ from the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17; and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).

(4) any new oath or declaration required by paragraph (f) of this subsection.

With respect to item (1), applicant has submitted a statement from the inventor being removed, Isabel MARCO MARTINEZ, in which the inventor states that the earlier error in inventorship did not result from deceptive intent on her part.<sup>1</sup> Item (1) is therefore

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<sup>1</sup>It is assumed that Isabel MARCO MARTINEZ was mistakenly listed on the international application. If in fact she was correctly listed in the PCT Request form and is now being removed because of a change in the claims, applicant should proceed pursuant to 37 CFR 1.48.

It is noted that the filing of a petition under 37 CFR 1.48(b) is not applicable prior to the application being executed by all the named inventors (including Isabel MARCO MARTINEZ). Under 35 U.S.C. 363, an international application designating the United States has the effect of a national application for a patent regularly filed in the United States. In other words, the U.S. national stage application is considered to have been filed on the international filing date in the names of the inventors/applicants for the United States of America listed on the REQUEST form.

37 CFR 1.48(f)(1), by its terms, applies only to a non-provisional application filed under 37 CFR 1.53(b). (See also, 37 CFR 1.9(a)(3)). A national application resulting from an international application entering the national stage under 37 U.S.C. 371 is not an application filed under 37 CFR 1.53(b), but an application that has entered that national stage under 37 CFR 1.494 or 1.495.

satisfied.

With respect to item (2), applicant has submitted the required \$130 processing fee. Item (2) is therefore satisfied.

Item (3) has not been satisfied. Applicant has not provided the assignee's consent to the removal of Isabel MARCO MARTINEZ as an inventor herein. Applicant must provide such consent before item (3) can be considered satisfied. Such consent must be accompanied by a statement under 37 CFR 3.73(b) which includes either a copy of the assignment documents or a specific reference to the assignment's recorded location in the USPTO (i.e., reel and frame number) (see 37 CFR 3.73(b)).

Item (4) does not apply to the present application.

Because applicant has not satisfied all the requirements of 37 CFR 1.497(d), inventor Isabel MARCO MARTINEZ cannot be removed from the application on the present record.

### **CONCLUSION**

Applicant's request to remove inventor Isabel MARCO MARTINEZ under 37 CFR 1.497(d) is **DISMISSED** without prejudice. The inventors of record remain the inventors named on the international application.

Applicant must file a proper response to this decision within **TWO (2) MONTHS** from the mail date indicated above. A proper response must include a written consent of assignee in compliance with 37 CFR 3.73(b). Failure to file a timely and proper response will result in abandonment of the application. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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